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OFFICE OF PETITIONS

In re Application of: :
Morimoto et al. : DECISION ON PETITION
Appl. No. 10/766,747 : UNDER 37 CFR 1.183
Filed January 28, 2004 :
Atty. Docket No. A0407-001592A:

This is a decision on petition filed under 37 CFR 1.47 on September 14, 2005 which is properly treated under 37 CFR 1.183¹ requesting suspension or waiver of the regulations (presumably 37 CFR 1.172) that require the inventors to sign any supplemental declaration in a broadening reissue application.

Petitioner requests waiver of the rule (presumably §1.172) that requires that the inventor sign any supplemental declaration in a broadening reissue application.

The petition is granted.

BACKGROUND

1. U.S. Patent No. 6,342,590 issued to Morimoto, Adachi, Matsunaga, Kashimura, Watanbe and Sota, on January 29, 2002.
2. A broadening reissue application (the present application) was filed for on January 28, 2004, and it was assigned application number 10/766,747.
3. During the prosecution of the application, the Office

¹If a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration listing all the inventors, and signed by all the available inventors may be filed provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor. MPEP 1414.01

required a supplemental reissue declaration directed to errors in the original patent which were corrected in the application after the signing of the original reissue declaration.

4. On September 14, 2005, applicant filed the present petition under 37 CFR 1.47 properly treated under 37 CFR 1.183 requesting suspension or waiver of the "regulations pertaining to the filing of a Supplemental Declaration under 37 C.F.R. § 1.175" that require a supplemental reissue declaration to be signed by the inventors.

5. The petition is accompanied by a "Supplemental Reissue Declaration," signed by five of the six inventors. It is for this supplemental declaration that the petition requests acceptance, via suspension or waiver of the regulations.

6. The petition proffers a showing, including a statement of facts by Keiko Koishi manager of assignee Taisho Pharmaceutical Company, Ltd., to establish that the inventor Matsunaga is unavailable to sign the supplemental reissue declaration. The petition and statement of facts, sets forth (a) the efforts made to contact each of the inventors and obtain their requisite signatures on the supplemental declaration, and (b) the lack of success of such efforts to obtain the signature of inventor Matsunaga.

DECISION

35 U.S.C. 251, which is directed to reissue, does not address the signature requirements of a declaration in reissue. 37 CFR 1.172 requires that a reissue declaration be made (and signed) by the inventors, except as otherwise provided (§§ 1.42, 1.43, 1.47), where the scope of the claims of the original patent is being enlarged. 37 CFR § 1.175(b)(1), requires that:

"For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant."

37 CFR 1.175(b)(1), taken in conjunction with § 1.172, requires a supplemental declaration to be signed by all inventors. This is because all oaths or declarations necessary to fulfill the rule

requirements in a reissue application are taken together collectively as a single oath or declaration. Thus, each oath and/or declaration must bear the appropriate signature of the inventor(s).

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.175(b)(1) supplemental declaration be signed by all of the inventor.

The instant petition is accompanied by an appropriate showing that inventor Matsunaga is unavailable. Accordingly, the supplemental declaration, signed by five of the six inventors will be accepted as though it was signed by the inventor as required by 37 CFR 1.175(b)(1) taken in conjunction with § 1.172.

CONCLUSION

The present petition to waive 37 CFR 1.172 is granted. Pursuant to petitioner's request deposit account no. 16-0633 will be charged the \$400.00 petition fee.

The application is being forwarded to Technology Center 1600 for further prosecution.

Please direct any questions related to this decision to the undersigned, at (571) 272-3215.



Charlema R. Grant
Petition Attorney
Office of Petitions



EXPRESS MAIL LABEL NO.: EJ771306230US
ATTORNEY DOCKET NO.: A0407-001592A

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|-------------------------------------|---|-------------------|
| Reissue Serial Number: |) | |
| 10/766,747 |) | |
| |) | |
| Applicants: Shigeo Morimoto et al. |) | Group Art Unit: |
| |) | 1623 |
| Filed: January 28, 2004 |) | |
| |) | Confirmation No.: |
| In re Reissue Application |) | 3658 |
| of U. S. Patent No. 6,342,590 |) | |
| |) | Examiner: |
| For: Erythromycin A Derivatives and |) | Elli Peselev |
| Method for Preparing Same |) | |

PETITION UNDER 37 C.F.R. §1.47

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Madam:

1. Applicants hereby petition to submit a supplemental declaration in the above-referenced application signed by five of the six inventors on behalf of an inventor who refuses to sign this supplemental declaration.
2. Taisho Pharmaceutical Company, Ltd. is assignee of the entire interest in U.S. Patent No. 6,342,590, the invention described therein, and in any reissue thereof by assignment recorded at Reel 4770, Frame 0623, including the above-referenced application.
3. Ms. Keiko Koishi, Manager of Intellectual Property Division of Taisho Pharmaceutical Company, and the person who has direct knowledge of the facts, has provided a statement of facts to accompany this petition.

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02 FC:1463 70.00 DA 130.00 DP
11/10/2005 AKELLEY 00000003 160633 10766747
01 FC:1462 400.00 DA
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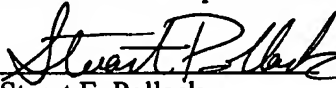
4. According to this statement of facts, one of the joint inventors, Mr. Tohru Matsunaga, refuses to sign a supplemental declaration for the above-referenced reissue application. This supplemental declaration has been signed by the other five joint inventors.

5. Mr. Tohru Matsunaga's current address is: 846-5 [2-212], Kokuki, Kuki-shi, Saitama 346-0001, Japan.

6. Because Mr. Matsunaga refuses to sign this Supplemental Reissue Declaration, Applicants request that the Office of Petitions grant this petition, so that the above-referenced application can be promptly allowed.

7. A check for the required petition fee of \$130.00 has been enclosed for this petition. Please charge any additional required fees to our Deposit Account No. 16-0633.

Dated: September 14, 2005


Stuart E. Pollack
Reg. No. 43,862

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